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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,094	01/24/2005	Enrico Gerardus Albertus Linders	70059USPCT	9236
22847 7590 03/06/2008 SYNGENTA BIOTECHNOLOGY, INC. PATENT DEPARTMENT 3054 CORNWALLIS ROAD P.O. BOX 12257 RESEARCH TRIANGLE PARK, NC 27709-2257				
EXAMINER ROBINSON, KEITH O'NEAL				
ART UNIT 1638		PAPER NUMBER		
MAIL DATE 03/06/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,094

**Applicant(s)**

LINDERS ET AL.

**Examiner**

KEITH O. ROBINSON

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10, 11, 17-24, 27-33, 35, 41-43 and 46-52 is/are pending in the application.
- 4a) Of the above claim(s) 27-33, 35, 41-43 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 17-24, 46-49, 51 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action mailed September 18, 2007. Applicant's amendment of claims 1, 11, 22-24, 46, 47, 51 and 52, cancellation of claims 9, 12-16, 25, 26, 34, 36-40, 44 and 45 and withdrawal of claims 27-33, 35, 41-43 and 50, filed December 7, 2007, have been received and entered in full.

Claims 1-8, 10, 11, 17-24, 46-49, 51 and 52 are under examination.

### ***Response to Arguments***

Applicant's arguments, see pages 8-9 of 'Remarks' filed December 7, regarding the 35 USC § 112, first paragraph rejection on pages 5-7 for lack of enablement of the Office Action mailed September 18, 2007, have been fully considered and found persuasive. The rejection has been withdrawn.

Applicant's arguments, see page 9, 2<sup>nd</sup> - 4<sup>th</sup> paragraphs of 'Remarks' filed December 7, regarding the 35 USC § 102 rejections on pages 7-9 of the Office Action mailed September 18, 2007, have been fully considered and found persuasive. The rejections have been withdrawn.

Applicant's arguments, see page 9, 5<sup>th</sup> paragraph to page 10, 3rd paragraph of 'Remarks' filed December 7, regarding the 35 USC § 102/103 rejection on pages 9-12 of the Office Action mailed September 18, 2007, have been fully considered and found persuasive. The rejection has been withdrawn.

***Claim Rejections - 35 USC § 112, first paragraph – Written Description***

Claims 1-8, 10, 11, 17-24, 46-49, 51 and 52 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed September 18, 2005, as applied to claims 1-11, 17-24, 46-49, 51 and 52 (see pages 3-5). Applicant's arguments, filed December 7, 2007, have been fully considered but are not persuasive.

Applicant argues that the standard set forth in *Vas-Cath, Inc.* and subsequently the MPEP is further illuminated by more recent decisions of the CAFC (see page 6, 4<sup>th</sup> paragraph of 'Remarks' filed December 7, 2007).

This is not persuasive. Applicant states that in *New Railroad Mfg., L.L.C. v. Vermeer Mfg. Co.*, the court stated that the written description requirement requires that the disclosure must show he had invented each feature that is included as a claim limitation; however, the instant specification only shows that Applicant invented and was in possession of *B. oleracea* line CFL667, wherein said line was derived from an interspecific cross of clubroot resistant Chinese cabbage F1 hybrid (clubroot resistant *B. rapa* plant) from Japan commercially available under the name 'Parkin' and an undisclosed broccoli plant (see, for example, pages 10-11). In addition, the specification discloses, "the resistance to clubroot according to the present invention is obtainable

from line CFL667 (see page 11, lines 11-12). Applicant further states that in *Lockwood v. American Airlines, Inc.*, the court cited *Vas-Cath, Inc.* as setting for the appropriate standard and then stated one shows that one is in possession of the invention by describing the invention, with all its claimed limitations; however, as discussed above, Applicant shown possession of was in possession of *B. oleracea* line CFL667, wherein said line is described with all its claimed limitations.

Applicant argues that the question is whether Applicant invented a *B. oleracea* plant with the claimed characteristics and whether those claim limitations are disclosed in the specification (see page 7, 1st – 2<sup>nd</sup> paragraphs of 'Remarks' filed December 7, 2007).

This is not persuasive. The question not whether Applicant invented a *B. oleracea* plant with the claimed characteristics and whether those claim limitations are disclosed in the specification because the specification discloses that Applicant has invented a *B. oleracea* plant with the claimed characteristics, namely *B. oleracea* line CFL667 (see, for example, page 11, lines 7-10). The question is whether Applicant was in possession of representative number of *B. oleracea* plant resistant to clubroot disease, wherein the resistance is obtained from a clubroot resistant *B. rapa* plant and the resistance to clubroot is monogenic and dominant as is broadly claimed. The instant specification discloses that Applicant was in possession of *B. oleracea* line CFL667, wherein the resistance is obtained from a clubroot resistant *B. rapa* plant and the resistance to clubroot is monogenic and dominant (see, for example, page 11, lines 11-

12, where it states, “the resistance to clubroot according to the present invention is obtainable from line CFL667”).

Applicant argues that page 3, lines 24-25 of the specification states, “In another preferred embodiment, the resistance is obtainable from a clubroot resistant *B. rapa* plant, preferably from Chinese cabbage F1 hybrid Parkin” and that this is evidence that Applicant was in possession of any and all *B. oleracea* plant with monogenic and dominant resistance to clubroot, as is broadly claimed, and not just *B. oleracea* line CFL667 (see page 7, 4<sup>th</sup> paragraph to page 8, lines 1-5 of ‘Remarks’ filed December 7, 2007).

This is not persuasive. The fact that Chinese cabbage F1 hybrid Parkin is publicly available does not provide evidence of possession of the claimed invention. Chinese cabbage F1 hybrid Parkin is a *B. rapa* plant and is used as a parent to introgress the monogenic and dominant resistant gene into *B. oleracea*. In the instant application, Chinese cabbage F1 hybrid Parkin was used to develop *B. oleracea* line CFL667 (see, for example, page 10, line 5 to page 11, line 10). The specification only provides evidence that Applicant was in possession of *B. oleracea* line CFL667.

In addition, Applicant states that the written description is not limited to line CFL667 (see page 7, 5<sup>th</sup> paragraph of ‘Remarks’ filed December 7, 2007); however, the specification only provides evidence that Applicant was in possession of *B. oleracea* line CFL667 (see, for example, page 11, lines 7-10).

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH O. ROBINSON whose telephone number is (571)272-2918. The examiner can normally be reached Monday – Friday, 7:30 a.m. - 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.  
Examiner  
Art Unit 1638

/Medina A Ibrahim/  
Primary Examiner, Art Unit 1638

February 27, 2008